

Notice of Allowability

Application No.

10/758,636

Applicant(s)

HAN ET AL.

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment 18 October 2006.
2. ☒ The allowed claim(s) is/are 1-8, 10, 11, 46-48 and 59-64.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

The amendment filed October 18, 2006 amending the specification to correct typographical error, amending claims 1-3, 8, 10, 59, 61 and 62 has been entered.

Claims 1-8, 10, 11, 46-48 and 59-64 are pending. Claims 61-64 have been previously withdrawn.

Election/Restrictions

Claim 59 is directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claims 61 and 62, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claims 63 and 64 dependent from claim 59 are drawn to a product and are rejoined as well.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement as set forth in the Office action mailed on November 14, 2005 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the

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provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dr. Lynn Janulis on January 2, 2007.

The application has been amended as follows:

IN THE SPECIFICATION:

On page 1, as amended on 1/15/04,

line 5,

insert --now U.S. Patent 6,706,505-- and delete "in turn".

IN THE CLAIMS:

In claim 1,

lines 11-12,

delete "of the polypeptide set forth in SEQ ID NO:4";

line 13,

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insert --the full length of-- before "any of (a)-(c)".

In claim 2,

line 4,

replace "90" with --95--;

line 6,

delete "of the polypeptide set forth in SEQ ID NO:4";

line 8,

replace "SEQ ID NO:3; (a); or (b)" with --SEQ ID NO: 3 or (a)--;

lines 9-10,

delete "of the polypeptide set forth in SEQ ID NO:4";

delete lines 11-17, clauses (c) and (d) in their entirety;

line 18,

replace "(e)" with --(c)-- and insert --the full length of-- before "any of";

line 19,

replace "(d)" with --(b)--.

In claim 3,

lines 5-6, 9-10, 13-14, 17-18, 23 and 29-30,

delete "of the polypeptide set forth in SEQ ID NO:4";

line 31,

insert --the full length of-- before "any of (a)-(e)".

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In claim 5,

replace "A" before "host cell" with --An isolated--.

In claim 47,

replace "A" before "composition" with --The--.

In claim 59,

line 1,

delete "diagnostic";

line 4,

replace "variant or homolog thereof" with --wherein said fragment has E3 α ubiquitin ligase activity--.

In claim 60, line 1,

delete "diagnostic".

In claims 61 and 62, lines 6, 7, 10, 12 and 13,

delete "diagnostic".

In claims 63 and 64, line 1,

replace "method" with --reagent--.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky, PhD whose telephone number is 571-272-0941. The examiner can normally be reached on M-F 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, PhD can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit 1652

January 3, 2007